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Docket No.: V9661.0019
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of On-Kwok V. Li et al.

Confirmation No.: 5203

Application No.: 09/877,744

Art Unit: 2141

Filed: June 8, 2001

Examiner: K. R. Coulter

For: SELF-ROUTING ADDRESS ASSIGNMENT IN
PACKET-SWITCHED NETWORKSMay 20, 2009
New York, NYRESPONSE TO AND REQUEST FOR WITHDRAWAL
AND REISSUANCE OF THE EXAMINER'S NOVEMBER 25, 2008
NOTICE OF NON-COMPLIANT AMENDMENT (37 C.F.R. §1.121)MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicants, through their undersigned attorney of record, respectfully request withdrawal of the examiner's pending, heretofore unresponded-to *Office communication* which includes a *Notice of Non-Compliant Amendment (37 C.F.R. §1.121)* [collectively "Office action"].¹ The enclosed copy of the Office action was obtained from the PTO's PAIR system following a telephone call from the examiner as explained below.

As presently advised, the Office action appears on its face to have been mailed from the PTO to the undersign's law firm, Dickstein Shapiro LLP ("Dickstein") on November 25, 2008. The undersigned was informed of this fact for the first time on May 9, 2009 in a phone call he received on that day from the examiner, Mr. K. R. Coulter. The purpose of the examiner's phone call was to

¹ In substance, the Office action simply requires that the status identifier for claim 18 on page 6 of the August 19, 2008 *Response to Non-Final Office Action* be corrected from "(Original)" to -- (Previously presented) --.

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inquire as to whether or not applicants intended to respond to the Office action inasmuch as the one (1)-month/thirty (30)-day response period had already expired and the non-extendible six (6)-month period will expire on May 26th. In reply, the undersigned said that he was unable to answer the question because he did not recall nor was he aware of the Office action.

Immediately following the examiner's May 9th phone call, the undersigned checked his case file on the subject application (which has been on his docket for the entire relevant period) and determined that the Office action was not in the file. Then he asked Dickstein's docketing department to check on the status of the Office action. Since all papers received from the PTO are immediately logged onto Dickstein's case management system, and that since no entry for the Office action was made, it confirmed that the latter was never received by Dickstein. In Dickstein's docketing department, each incoming paper from the PTO is entered on a daily basis into a log on the page corresponding to the initial (shortened statutory) due date indicated on the face of the paper as having been mailed from the PTO. At the same time, the information is entered into the log on the page corresponding to the non-extendible (six (6)-month) deadline for responding to the paper which is then forwarded for physical entry into the case file. Attached are complete and correct copies of Dickstein's docketing department's log page for December 25, 2008 (the initial due date for response to the Office action) and the log page for May 25, 2009 (the six (6)-month due date for response). It can be seen from these pages that the Office action was never logged onto Dickstein's case management system and hence was never received.

It is respectfully submitted therefore, that because the Office action was not received from the PTO by the undersigned or his law firm, and because it did not come to their attention until the May 9th phone call from the examiner, filing a response to it at this time, although timely because the application is still pending, would necessitate payment of a substantial fee for a five (5)-month extension of the response time from the one (1)-month due date to the May 26th six (6)-month non-extendible due date. It would be manifestly unfair to require applicants to pay the significant extension fee required at this time. Had the Office action been received by the undersigned and his law firm in the normal course of mail delivery, then he certainly would have

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responded to it within the one (1)-month/thirty (30)-day response period for which no extension would have been required.

Hence, it is requested that the current Office action be withdrawn and replaced with a new office action to which the applicants can respond without having to pay for an extension of time. In a post-May 9th phone conversation between the undersigned and examiner Coulter, the examiner indicated that he would withdraw the Office action and reissue it upon receipt of this submission.

The examiner is respectfully requested to issue an examiner interview summary to confirm the foregoing telephone calls. In addition, as an alternative to withdrawing the Office action and issuing a new one, in order to advance the prosecution of the subject application, and if deemed appropriate, the examiner is invited to consider issuing an examiner's amendment correcting the status identifier for claim 18 (see footnote 1, *supra*).

Dated: May 20, 2009

Respectfully submitted,

By 

Charles E. Miller

Registration No.: 24,576

DICKSTEIN SHAPIRO LLP

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New York, New York 10036-2714

(212) 277-6500

Attorney for Applicant

Attachments

DECEMBER

25

THURSDAY

2008 360th day - 6 days follow

Christmas

Case No.	Applicant	Amount	Description	Deadline	Notes
CEM	V9661-0044	10,822.585	RESP TO OA + 3	DEADLINE 9/25	CASE TRANS.
LCB	V0195-0044	11,142.007	RESP TO OA + 3	DEADLINE 12/13	
SIW/JWR	E2331-0507	10,109.981	FINAL REJECT + 3	DEADLINE 10/11	
SIW/JWR	E2331-0507	10,109.981	NOTICE OF APPEAL + 3	DEADLINE 10/11	VACATED
CEM	C3540-0009	11,589.999	RESP TO OA	EXT	
RI	M1071-1955	10,562.569	RESP TO OA	EXT	
EAM	M1071-2074	12,099.633	RESP TO OA	12/11	
LCB	F0007-0001	11,670.155	RESP TO OA + 1	EXT	

2009 145th day - 220 days follow

Memorial Day, Observed (US)

MONDAY

25

MAY

FAMIRCG	CO300-0002	10/491.206	FINAL REJECT + 3	DEADLINE 1/20
FAMIRCG	CO300-0002	10/491.206	NOTICE OF APPEAL + 3	DEADLINE 1/20
LCB	ED196-0159	09/794.661	FINAL REJECT + 3	DEADLINE 3/25
LCB	ED196-0159	09/794.661	NOTICE OF APPEAL + 3	DEADLINE 3/25
RLIAP	W1878-0230	10/575.631	RESP TO OA + 3	DEADLINE 3/24
RLIWR	Y2238-0054	10/716.622	FINAL REJECT + 3	DEADLINE 1/9
RLIWR	Y2238-0054	10/716.622	NOTICE OF APPEAL + 3	DEADLINE 4/29
RLIAP	Y2238-0077	11/449.741	RESP TO OA + 3	DEADLINE 3/26
RL	M1071-1973	10/586.488	FINAL REJECT	REC 4/13
RL	M1071-1973	10/586.488	NOTICE OF APPEAL	REC 4/13
RLIRCA	W1878-0320	11/197.397	RESP TO OA	4/15
RLIWR	N0029-1658	10/017.029	APPEAL BRIEF + 4	ABANDONED
MTS	L1105-0103	10/493.888	REST REQ + 1	BASE TRANS

RLIWR	G0126-0245	11/303.502	ISSUE FEE	5/13
MTS	T2171-0222	11/073.762	ISSUE FEE	5/8

MAY 20 2009



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/877,744	06/08/2001	On-Kwok Victor Li	9661-0019	5203

7551 11/25/2008
CHARLES E MILLER
DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP
1177 AVENUE OF THE AMERICA
4TH FLOOR
NEW YORK, NY 10036-2714

EXAMINER

COULTER, KENNETH R

ART UNIT PAPER NUMBER

2441

MAIL DATE DELIVERY MODE

11/25/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



UNITED STATES DEPARTMENT OF COMMERCE

U.S. Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
09877744	6/8/2001	LI ET AL.	9661-0019

CHARLES E MILLER
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1177 AVENUE OF THE AMERICA
4TH FLOOR
NEW YORK, NY 10036-2714

EXAMINER

Kenneth R. Coulter

ART UNIT	PAPER
2441	20081122

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

see attached sheets

/Kenneth R Coulter/
Primary Examiner, Art Unit 2441

PTO-90C (Rev.04-03)

Application/Control Number: 09/877,744
Art Unit: 2441

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Response to Amendment

1. The amendment to the claims filed on 8/19/08 does not comply with the requirements of 37 CFR 1.121(c) because inconsistencies exist in status of claim 18. The status identifier for claim 18 (Original) is not correct.

37 CFR 1.121(c) clearly states "In the claim listing, the status of every claim must be indicated after its claim number by using one of the following identifiers in a parenthetical expression: (Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented), (New), and (Not entered)."

Amendments to the claims filed on or after July 30, 2003 must comply with 37 CFR 1.121(c) which states:

(c) *Claims*. Amendments to a claim must be made by rewriting the entire claim with all changes (e.g., additions and deletions) as indicated in this subsection, except when the claim is being canceled. Each amendment document that includes a change to an existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, in the application. The claim listing, including the text of the claims, in the amendment document will serve to replace all prior versions of the claims, in the application. **In the claim listing, the status of every claim must be indicated after its claim number by using one of the following identifiers in a parenthetical expression: (Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented), (New), and (Not entered).**

(1) *Claim listing*. All of the claims presented in a claim listing shall be presented in ascending numerical order. Consecutive claims having the same status of "canceled" or "not entered" may be aggregated into one statement (e.g., Claims 1-5 (canceled)). The claim listing shall commence on a separate sheet of the amendment document and the sheet(s) that contain the text of any part of the claims shall not contain any other part of the amendment.

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(2) *When claim text with markings is required.* All claims being currently amended in an amendment paper shall be presented in the claim listing, indicate a status of "currently amended," and be submitted with markings to indicate the changes that have been made relative to the immediate prior version of the claims. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. Only claims having the status of "currently amended," or "withdrawn" if also being amended, shall include markings. If a withdrawn claim is currently amended, its status in the claim listing may be identified as "withdrawn—currently amended."

(3) *When claim text in clean version is required.* The text of all pending claims not being currently amended shall be presented in the claim listing in clean version, i.e., without any markings in the presentation of text. The presentation of a clean version of any claim having the status of "original," "withdrawn" or "previously presented" will constitute an assertion that it has not been changed relative to the immediate prior version, except to omit markings that may have been present in the immediate prior version of the claims of the status of "withdrawn" or "previously presented." Any claim added by amendment must be indicated with the status of "new" and presented in clean version, i.e., without any underlining.

(4) *When claim text shall not be presented; canceling a claim.*

(i) No claim text shall be presented for any claim in the claim listing with the status of "canceled" or "not entered."

(ii) Cancellation of a claim shall be effected by an instruction to cancel a particular claim number. Identifying the status of a claim in the claim listing as "canceled" will constitute an instruction to cancel the claim.

(5) *Reinstatement of previously canceled claim.* A claim which was previously canceled may be reinstated only by adding the claim as a "new" claim with a new claim number.

2. Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. **EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).**

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth R. Coulter whose telephone number is 571 272-3879. The examiner can normally be reached on M - F, 7:30 am - 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571 272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kenneth R Coulter/
Primary Examiner, Art Unit 2441

/KRC/

MAY 20 2009

**Notice of Non-Compliant
Amendment (37 CFR 1.121)**

Application No.

09/877,744

Examiner

Kenneth R. Coulter

Applicant(s)

LI ET AL.

Art Unit

2441

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

The amendment document filed on 19 August 2008 is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121 or 1.4. In order for the amendment document to be compliant, correction of the following item(s) is required.

THE FOLLOWING MARKED (X) ITEM(S) CAUSE THE AMENDMENT DOCUMENT TO BE NON-COMPLIANT:

- ☐ 1. Amendments to the specification:
- ☐ A. Amended paragraph(s) do not include markings.
 - ☐ B. New paragraph(s) should not be underlined.
 - ☐ C. Other _____.
- ☐ 2. Abstract:
- ☐ A. Not presented on a separate sheet. 37 CFR 1.72.
 - ☐ B. Other _____.
- ☐ 3. Amendments to the drawings:
- ☐ A. The drawings are not properly identified in the top margin as "Replacement Sheet," "New Sheet," or "Annotated Sheet" as required by 37 CFR 1.121(d).
 - ☐ B. The practice of submitting proposed drawing correction has been eliminated. Replacement drawings showing amended figures, without markings, in compliance with 37 CFR 1.84 are required.
 - ☐ C. Other _____.
- ☒ 4. Amendments to the claims:
- ☐ A. A complete listing of all of the claims is not present.
 - ☐ B. The listing of claims does not include the text of all pending claims (including withdrawn claims)
 - ☒ C. Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified. Note: the status of every claim must be indicated after its claim number by using one of the following status identifiers: (Original), (Currently amended), (Canceled), (Previously presented), (New), (Not entered), (Withdrawn) and (Withdrawn-currently amended).
 - ☐ D. The claims of this amendment paper have not been presented in ascending numerical order.
 - ☒ E. Other: The status identifier for claim 18 (Original) is not correct.
- ☐ 5. Other (e.g., the amendment is unsigned or not signed in accordance with 37 CFR 1.4):

For further explanation of the amendment format required by 37 CFR 1.121, see MPEP § 714.

TIME PERIODS FOR FILING A REPLY TO THIS NOTICE:

- Applicant is given **no new time period** if the non-compliant amendment is an after-final amendment or an amendment filed after allowance. If applicant wishes to resubmit the non-compliant after-final amendment with corrections, the entire corrected amendment must be resubmitted.
- Applicant is given **one month**, or thirty (30) days, whichever is longer, from the mail date of this notice to supply the correction, if the non-compliant amendment is one of the following: a preliminary amendment, a non-final amendment (including a submission for a request for continued examination (RCE) under 37 CFR 1.114), a supplemental amendment filed within a suspension period under 37 CFR 1.103(a) or (c), and an amendment filed in response to a Quayle action. If any of above boxes 1. to 4. are checked, the correction required is only the corrected section of the non-compliant amendment in compliance with 37 CFR 1.121.

Extensions of time are available under 37 CFR 1.136(a) only if the non-compliant amendment is a non-final amendment or an amendment filed in response to a Quayle action.

Failure to timely respond to this notice will result in:

- Abandonment** of the application if the non-compliant amendment is a non-final amendment or an amendment filed in response to a Quayle action; or
- Non-entry** of the amendment if the non-compliant amendment is a preliminary amendment or supplemental amendment.

/Kenneth R Coulter/
Primary Examiner, Art Unit 2441

U.S. Patent and Trademark Office
PTOL-324 (01-06)

Notice of Non-Compliant Amendment (37 CFR 1.121)

Part of Paper No. 20081122